

**REMARKS**

Applicant has amended claims 10, 13, and 16. The amendments to the claims are supported by the original claims and as-filed application, e.g., paragraph [0043]. No new matter has been introduced.

The Examiner maintained the provisional rejection of claims 10-18 on the grounds of nonstatutory obviousness-type double patenting over claims 1-9 of copending Application No. 10/565,739. Since no claims are allowable in either of the relevant applications, Applicant respectfully requests that the double patenting rejection be held in abeyance until allowable subject matter is indicated either in the present application or in Application No. 10/565,739. Once allowable subject matter is indicated, and if the Examiner has not withdrawn the obviousness-type double patenting rejection, Applicant at that time will file a Terminal Disclaimer. See M.P.E.P. § 804(I)(B).

Applicant respectfully traverses the rejection of claims 13, 14, 16, and 17 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,403,503 to Seiki et al. ("Seiki") for at least the following reasons.

Amended claim 13 recites, among other things, at least one oxygen-containing compound selected from the group consisting of the following (A1), (A3), (A4), and (A5): (A1) Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups; (A3) Trihydric alcohol having 3-20 carbon atoms apart from (A1); (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol; and (A5) Hydrocarbyl ether of (A1)-(A4).

Amended claim 16 recites, among other things, at least one oxygen-containing compound selected from the group consisting of the following (A1), (A4), and (A7): (A1) Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups; (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol; (A7) Hydrocarbyl ether of (A1) or (A4).

Seiki does not disclose either at least one oxygen-containing compound selected from the group consisting of the above (A1), (A3), (A4), and (A5), as recited in amended claim 13, or at least one oxygen-containing compound selected from the group consisting of the above (A1), (A4), and (A7), as recited in amended claim 16.

Since anticipation under § 102 requires that all of the claim elements be disclosed, expressly or inherently in a single reference, amended claims 13 and 16 are not anticipated by Seiki. Claims 14 and 17 depend from claims 13 and 16, respectively, and incorporate all of the features of the claims from which they depend. Accordingly, claims 14 and 17 also are allowable over Seiki.

Applicant respectfully traverses the rejection of claim 10-12 under 35 U.S.C. §103(a) over Seiki in view of U.S. Patent No. 6,667,285 to Kawahara et al. ("Kawahara").

Amended claim 10 recites, among other things, a full ester of a diol or a polyol having 3-20 hydroxyl groups with a fatty acid having 6-20 carbon atoms as a base oil and at least one ester additive selected from monoesters of a monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms. The term "full ester" is supported by the as-filed specification, e.g., at paragraph [0043].

Seiki neither discloses nor suggests at least the above-mentioned features of amended claim 10. Kawahara also neither discloses nor suggests at least a full ester of a diol or a polyol having 3-20 hydroxyl groups with a fatty acid having 6-20 carbon atoms as a base oil, as recited in amended claim 10. Accordingly, combining Kawahara with Seiki does not remedy the deficiency of Seiki standing alone. For at least these reasons, amended claim 10 and its dependent claims 11 and 12 are allowable over Seiki and Kawahara.

Applicant also respectfully traverses the rejection of claims 15 and 18 under § 103(a) over Seiki in view of U.S. Patent No. 6,228,282 to Shimomura et al. ("Shimomura").

Claim 15 depends from amended claim 13, and incorporates all of the features recited in amended claim 13. As discussed above, Seiki neither discloses nor suggests at least at least one oxygen-containing compound selected from the group consisting of the above (A1), (A3), (A4), and (A5), as recited in amended claim 13. Shimomura does not cure the deficiency of Seiki. Shimomura discloses at col. 2, lines 21-40, col. 8, lines 18-31, and col. 8 line 62- col. 9, line 6, a refrigerating machine oil composition comprising an alicyclic polycarboxylic acid ester compound, an epoxy compound and additives, but does not disclose or suggest any of the specific oxygen-containing compounds recited in amended claim 13. Shimomura, therefore, does not provide to the deficient teachings of Seiki, a known solution with a predictable result.

Claim 18 depends from amended claim 16, and incorporates all of the features recited in amended claim 16. As discussed above, Seiki neither discloses nor suggests at least at least one oxygen-containing compound selected from the group consisting of

the (A1), (A4), and (A7) recited in amended claim 16. Shimomura also fails to disclose or suggest these claim features. Shimomura discloses at col. 2, lines 21-40, col. 8, lines 18-31, and col. 8 line 62- col. 9, line 6, a refrigerating machine oil composition comprising an alicyclic polycarboxylic acid ester compound, an epoxy compound and additives, but does not disclose or suggest any of the specific oxygen-containing compounds recited in amended claim 13. This combination of references, therefore, fails to suggest claim 18.

For at least these reasons, amended claims 15 and 18 are allowable over Seiki and Shimomura.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of the claims, withdrawal of the rejections, and a timely notice of allowance.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 25, 2010

By: *Hojung Cho*  
Hojung Cho  
Ltd. Rec. No. 38,742  
(202)408-4000